

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

Amendments to the Drawings:

Attached herewith are replacement drawings for to Figures 1-3. It is believed these replacements do not involve any introduction of new matter. Consequently, entry of these replacement drawings is believed to be in order and is respectfully requested.

Attachment: Replacement Sheets for Figures 1-3

Appl. No. 09/902,144
Atty. Docket No. 8633
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Customer No. 27752

REMARKS

Claims 1, 3-8, 11-19 and 21-24 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 9 10, and 20 are canceled without prejudice.

Claims 1, 8 and 17 have been amended to more specifically characterize and claim Applicant's invention. Support for these amendments are found in original Claims 8-10, and at page 3, line 27 – page 5, line 6; page 8, line 27 – page 9, line 2; and page 12, line 9 – page 13, line 13 of the specification.

Claim 3-6 had been amended to more specifically characterize and claim Applicant's invention. Support for these amendments are found at page 11, line 3 – page 12, line 8 of the specification.

Claim 11 has been amended to correct the claim dependency to canceled Claim 10. Support for this amendment is found in Claims 8-11, as originally filed.

Claim 21 has been amended to correct the claim dependency to canceled Claim 20. Support for this amendment is found in Claims 17, 20 and 21, as originally filed.

Claim 22 has been amended to correct a typographical mistake regarding the inadvertent omission of "." at the end of the claim.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Objections

The Office Action states that Claim 22 is objected to because it appears that the claim is missing a "." at the end of the claim. As noted above, Claim 22 has been amended to remedy the inadvertent omission of punctuation and, it is submitted, the objection is now rendered moot and should be withdrawn.

Rejection Under 35 USC 112, Second Paragraph

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

The Office Action States that Claims 2 and 3 are rejected for failing to particularly pointing out and distinctly claiming the subject matter which the Applicant claims as its invention. The Office Action states that that Claims 2 and 3 recite the limitation "the other factors," thereby rendering the claim unclear as to what other factors the Applicant is referring due to a lack of antecedent basis. Applicant notes that Claim 3 does not contain the phrase "the other factors," but Claims 5 and 6 do utilize this phrase. Applicant assumes that the Examiner intended to refer to Claims 5 and 6, instead of Claim 3, in making the present rejection and will respond accordingly. If Applicant's assumption is in error the Applicant invites the Examiner to contact the Applicant's attorney.

As noted above Claim 2 has been cancelled without prejudice, and Claims 5 and 6 have been amended to provide proper antecedent basis for all elements of the claims. Accordingly Applicant respectfully suggests that continued rejection of Claims 5 and 6 on these grounds would be improper, and that the rejections should be withdrawn.

Rejection Under 35 USC 101

Claims 1-6 and 8-24 have been rejected under 35 USC 101 as being directed towards unpatentable subject matter. The Office Action states that Applicant's claimed invention is directed to non-statutory subject matter in that the invention fails to satisfy the "technological arts" test set forth in *In re Toma*, 575 F.2d 872, 197 USPQ (BNA) 852 (CCPA 1078). Applicant respectfully asserts that the rejection under 35 USC 101 on these grounds is in error and should be withdrawn.

The Office Action cites the case of *In re Toma*, 575 F.2d 872, 197 USPQ (BNA) 852 (CCPA 1978) for the proposition that inventions must pass a "technological arts" test in order to be deemed patentable subject matter under 35 USC 101 (Office Action Dated 11/05/2004; Page 3, Lines 15 – 18). Applicant respectfully asserts that reliance on *In re Toma* for this proposition is incorrect and inappropriate.

The Office Action specifically states that the court in *In re Toma* "found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer" (emphasis added) (Page 2, Line 24 – Page 3, Line 2). Applicant respectfully asserts that this interpretation of *In re Toma* is in error. The court in *In re Toma* was not creating a "technological arts" test, but instead was specifically addressing the rationale of the Examiner's in the final rejection of the subject claims, under 35 USC 101, that a computerized method of translating languages was not within the

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

"technological arts." The Patent Office in *In re Toma* argued that "as far as computer-related inventions are concerned, only those inventions that "enhance the internal operation of the digital computer" are 'technological' or 'useful' arts." *In re Toma* 575 F.2d 872, 877. The Patent Office further argued that the subject claims were not statutory subject matter because "natural language translation is a 'liberal art' and that effecting the translation by means of a machine does not transform the activity a 'technological art'." *Id.* The Court disagreed with this position.

The Court in *In re Toma* stated that:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter (a method of operating a machine to translate) is statutory, not on whether the product of the claimed subject matter (a translated text) is statutory, not on whether the prior art which the claimed subject matter purports to replace (translation by human mind) is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it enhances" the operation of a machine.

The Court, in stating such, was not establishing a "technological arts" test for patentable subject matter, but was rather specifically reversing the holding of the Board of Patent Appeals and Interferences that a computer enabled translation method for translating a source language into a target language was not statutory subject matter because such a method was not within the "technological arts." Accordingly, *In re Toma* does not, in fact, create a "technological arts" test for statutory subject matter under 35 USC 101.

As no such "technological arts" test exists, Applicants respectfully assert that continued rejection of Claims 1-6 and 8-24, as being directed towards unpatentable subject matter on these grounds, would be in error and that the rejection should be withdrawn.

Rejection Under 35 USC 102(b) Over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1)

Claims 1-9 and 12-24 have been rejected under 35 USC 102(b) as being unpatentable over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1). Applicant respectfully obviates this rejection.

As is well settled, anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). Furthermore, in a §102(b)

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As the Office Action expressly recognizes that the *Dulaney et al* reference does not disclose the use scenario data operable to receive hypothetical sets of constant value data (Office Action dated 11/03/2005, Page 8, Lines 11-13), Applicant respectfully asserts that the above referenced claims, as amended, are patentable and respectfully requests that the rejection under 35 USC 102(b) be withdrawn.

Rejection Under 35 USC 103(a) Over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1)

Claims 10 and 11 have been rejected under 35 USC 103(a) as being unpatentable over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1). Applicants respectfully traverse this rejection as there is no motivation to combine the cited references to achieve Applicant's claimed invention. Therefore, Applicants' contend that the claimed invention is unobvious and that the rejection should be withdrawn.

As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993).

As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the *Dulaney et al* and *Jameson* references in the manner suggested by the Examiner. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness.

A *prima facie* case of obviousness, however, requires that the rejection describe with specificity *why* one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999). ("Our case law makes clear

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of *the requirement for a showing of the teaching or motivation to combine prior art references.*"). In the present case, no such explanation is found in the rejection.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992).

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

Moreover, whether or not *Dulaney et al* and *Jameson* are non-analogous arts, it remains that the question of "non-analogous art" is relevant to whether it would be proper to combine references. *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). That is, even when references are in related arts, the Examiner still has the burden of establishing (1) that there is a suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make the invention as claimed. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner was required to demonstrate *where* in *Dulaney et al* and *Jameson* there is a suggestion which would have "strongly motivated" one to make product factor optimization systems as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have "*impelled*" one to do so (*Ex parte Levensgood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Because the Examiner has not identified *any* suggestion, reason, or other motivation, including suggestion of desirability, for *why* one would have combined the *Dulaney et al* and *Jameson* references, the rejection should be withdrawn. Accordingly, Applicant respectfully asserts that for these reasons the rejection of the above referenced claims under 35 USC 103(a) is in error and should be withdrawn.

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the objection to Claim 22, and the rejections under 35 USC 101, 35 USC 102(e), 35 USC 103(a), and 35 USC 112, Second Paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 3-8, 11-19 and 21-24.

Respectfully submitted,

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Customer No. 27752
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